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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/828,437  
Filing Date: April 06, 2001  
Appellant(s): PATULLO ET AL.

**MAILED**

JUN 29 2006

**GROUP 3600**

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Mark Hrozenchik  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed April 7, 2006 appealing from the Office action mailed January 12, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is essentially correct.

The Examiner notes that the appellant has used an improper heading. Appellant identifies the heading as Summary of the Invention, rather than Summary of Claimed Subject Matter.

Also, the Examiner requests that the Board disregard the discussion starting with the second paragraph under the heading of Summary of the Invention on page 1 of the appeal brief through to the last paragraph on page 3. The information provided by the appellant in these paragraphs is not directed to the claimed invention. The appellant addresses the drawings, especially Figures 1 and 12. Appellant does not start to

provide the concise explanation of the subject matter defined in the claims in this appeal until page 3.

37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

#### **(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is essentially correct. Jones et. al. is published application number US 2002/0156661, not 2001/0156661 as appellant indicates.

#### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

#### **(8) Evidence Relied Upon**

20020156661	Jones et al	10-2002
20030110063	Among et al	6-2003
6,018,715	Lynch et al	1-2000

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Lynch et al (6,018715) (hereinafter referred to as Lynch).

Referring to Claim 1:

Lynch discloses a reservation system for making travel arrangements upon request by a user, the system comprising:  
means for determining whether the user is a direct customer or a travel agent (*Figure 1 Decision Engine (16) Fig. 3 (106) Determine traveler, Business Entity and Agency Association, column 5, lines 31-35 – at block 106, in response to the travel request information, system 10 under the control of decision engine module 16 determines the identity of the traveler, the business entity which employs the traveler (if applicable), and the travel agency of which the individual is a customer (if applicable)*);

means for receiving travel parameters associated with a desired travel option (*Figure 1 (10); system 10 receives information relating to an incoming travel request col. 4, lines 13-14; Figure 2-workstation 34 – a user of system 10, such as a*

*travel agent, may input and receive travel and customer related information through any workstation (34), col. 4, lines 57-61).*

means for generating a listing of one or more travel arrangements in accordance with the travel parameters (*Decision engine module (16) - col. 3, lines 16-21 Decision engine module 16 functions to receive travel request information, such as a travel itinerary, input into system 10 and, in response, determines a preferred travel plan*); and

means for displaying the listing of one or more travel arrangements (*Figure 2 - workstation 34; col. 4, lines 57-61 a user of system 10 may input and receive travel and customer related information, including the travel plan generated by system 10*)

Referring to 2, 4-6, and 11:

Lynch discloses travel parameters as set forth in claims 4 and 11 (Travel Request Information Fig. 3 (104)) which includes time and dates of travel and types of services needed, col. 4, lines 13-18; col. 5, lines 25-29 the travel request information can include, for example, the name of a customer (individual and/or business entity), the time and dates of travel and types of travel services needed (e.g., airline flight, hotel automobile rental, etc.).

While Lynch discloses the travel request information including, for example, the name of a customer (individual and/or business entity), the time and dates of travel and types of travel services needed (e.g., airline flight, hotel automobile rental, etc.), Lynch does not explicitly disclose a system wherein the listing includes a plurality of room

accommodations and pricing information, wherein said listing includes information relating to whether children are allowed, wherein said listing indicates unavailability information, or wherein pricing information is provided. However, this data is determined to be non-functional descriptive data, not functionally interrelated with the structure of the system. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

Furthermore, an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114). The system in Lynch is fully capable of processing and displaying this type of data as is indicated by the language "*the travel request information can include, for example,*" and the *etc.* at the end of the listing of services, indicating that the listing is not all inclusive.

Referring to Claims 3 and 8-10:

Lynch discloses a means for displaying (workstation 34).

The fact that the means for displaying displays images associated with a plurality of room accommodations or flight options, or an indication of a limited flight availability is data that is deemed non-functional descriptive data, not functionally interrelated with the structure. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

Furthermore, an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114). The system of Lynch is fully capable of displaying images and flight options in the travel plan that the system 10 generates.

Referring to Claim 7:

Lynch discloses a system further including a means for accessing an associated computer network (Figure 2; col. 4, lines 25-65 - the mainframe computer 30 may be linked electronically to process server 26 through a local or wide area network (LAN/WAN).

Referring to Claim 12:

Lynch discloses a reservation system including means for generating a confirmed travel arrangement without receipt of payment for the arrangement (col. 3, *lines 16-21 decision engine module 16 functions to receive travel request information, such as travel itinerary, input into system 10 and, in response determines a preferred travel plan* col. 4, *lines 13-24 – system 10 determines a recommended travel plan or policy that balances between the preferences of the individual traveler*).

Referring to Claim 25:

Lynch discloses a reservation system making travel arrangements comprising: first data processing system (*Processing network 12*) for determining whether the user is a direct customer or a travel agent ((*Figure 1 Decision Engine (16) Fig. 3 (106) Determine traveler, Business Entity and Agency Association, column 5, lines 31-35 – at block 106, in response to the travel request information, system 10 under the control of decision engine module 16 determines the identity of the traveler, the*

*business entity which employs the traveler (if applicable), and the travel agency of which the individual is a customer (if applicable); receiving travel parameters associated with a desired travel option and generating a listing in accordance with the parameters and displaying the listing of the one or more travel arrangements (col. 3, lines 12-21 decision engine module 16 functions to receive travel request information, such as travel itinerary, input into system 10 and, in response determines a preferred travel plan; col. 4, lines 57-61 a user of system 10 may input and receive travel and customer related information (including the travel plan generated by the system 10 through any of the workstations 34); and*

*at least one database (Figure 1 (14) and col. 3, lines 31-37 and data storage device 28 col. 4, line 66 thru col. 5, line 7). The language for storing a plurality of the travel arrangements and the associated pricing information is the intended use of the structure and does not distinguish the claimed apparatus from the prior art since the databases of Lynch store information relating to travel preferences and are fully capable of storing travel arrangements and pricing information.*

Referring to Claim 26 and 27:

Lynch discloses a system comprising a polling computer (Figure 1 and (10) and col. 3, lines 6-30 automated travel planning system 10 includes a processing network 12 connected to a database 14 processing network 12 may consist of a single processor or, as described below with reference to Figure 2, a plurality of interconnected processors; processing network 12 functions to run one or more software applications or modules which can include a decision engine module 16 – decision engine module

16 functions to receive travel request information input into system 10 and, in response, determines a preferred travel plan for each traveler) for polling a first data processing system to transfer travel arrangement information (preferred travel plan) to a second data processing system and a third processing system (col. 3, lines 12-15 – Processing network 12 may consist of a plurality of interconnected processors).

The language “for polling the first data processing system to transfer travel arrangement information to a second data processing system and a third data processing system is the intended use of the processing system. A recitation of the intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The system in Lynch is fully capable of transferring data to a plurality of processing systems.

The fact that the data processing systems are identified as a central reservation system and a flight data server is non-functional descriptive data, not structurally related to the structure. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US 2002/0156661) (hereinafter referred to as Jones) in view of Among et al (US 2003/0110063) (hereinafter referred to as Among).

Referring to Claims 1 and 13:

Jones discloses a method and system for making travel arrangements using a computer network, comprising:

receiving travel parameters associated with a desired travel option (*Figure 2A (200) Receive Trip Parameters [0031], [0039] travel parameters include..*); generating a listing of one or more travel arrangements in accordance with the travel parameters (*[0030-0031]; Figure 7 (700) review itinerary [0056]*), said listing including pricing information associated with the travel parameters (*Figure 3B Available flights on 9/7 and prices shown, [0045] Fig. 3b also shows available flights and their times and prices, (Figure 8B) the Fare for this itinerary is \$578 per person, \$1156 for 2 passengers*); and

displaying the listing of the one or more travel arrangements (*[0031] the travel system sends display data to a display located at the user's site for displaying travel options, [0045] Figures 3b-3c show example screen displays presented on display 106, Figure 7 (700) and [0056] Once the itinerary is complete, RCS 128 sends display data to presentation program 108 which in turn displays the itinerary for the user to review (step 700); Figure 8B and Figure 8D*).

Jones does not disclose determining whether the user is a direct customer or a travel agent.

However, Among discloses a step of determining (login) who the user is, determining if a passenger is identified as qualified for special pricing and automatically applying a rate if qualified (Figure 4 step 407 If passenger identified as qualified for special pricing – rate is automatically applied), a customer information database (106) which includes client and customer information and identification [0039], allowing for tracking of sales by an individual or by an entity, sending confirmation messages to travel agent 605 and the buyer (606) and the ability to enroll online in an incentive program and receive special access to the site via the login and password which includes a travel agent [0052] (Figure 1 (102)(101) login, Figure 3 (300) customer inputs: resident state, name, other login information; page 5 [0052]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the login teachings of Among with travel planning disclosure of Jones since, by identifying the user, the travel planning method and system of Jones can access special pricing information, any incentives, and commission payments that may be available to the user, thus affecting the price of any reservation, and also allows for tracing of sales by an individual or by an entity and aids travel agents in managing commission payments.

Furthermore, the fact that the user is a direct user or a travel agent in the claim language above is determined to be non-functional descriptive data, not structurally related to the steps or the structure. Thus, this descriptive data will not distinguish the

claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

Referring to Claims 2 and 14:

Jones discloses a method and system wherein said listing includes a plurality of room accommodations, pricing information for the plurality of room accommodations. (Fig. 2A (230) Invoke Hotel Decision Support System, Fig. 4A (400) Hotel subsystem, [0008] traveler's itinerary is generated interactively with a user by selecting hotels [0030], page 3 [0047]).

Jones does not disclose the pricing information for the plurality of room accommodations *with one or more categories of airfare*. The Examiner is reading this to mean that the component prices of a package are shown, e.g., a total package price includes the cost of a room at a certain dollar amount and the cost of a flight at a specified dollar amount.

Among discloses the individual package component prices (Fig. 4 (401-406) which includes airline price data and hotel (accommodation) price data [0045] after the buyer has provided parameter information for components 400 and selected desired components 401, suboptions are generated and priced by the server 105 for selected components from the airline, hotel, car and other travel products/services price database).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the package components taught in Among with the travel planning

disclosure of Jones since this allows the customer to see that the customer is getting a better discount by booking flights and accommodations together in a package as opposed to making several independent reservations.

Referring to Claims 3 and 15:

Jones discloses a method and system wherein said method further comprises displaying images associated with the plurality of room accommodations, in response to selection of said plurality of room accommodations (Fig. 4A (420) send display data with amenities, views, descriptions, Figure 4B and [0047]).

Referring to Claims 4 and 16:

Jones discloses a method and system wherein said travel parameters include accommodation name, arrival date, departure date, departure location, and number of guests (Fig. 4A, [0030-0031] destination time, site , and an origination site [0039] origination airport, origination city, arrival date and time, duration, required return time).

The fact that the travel parameter includes whether children are allowed is determined to be non-functional descriptive data, not functionally related to the steps or method. This data does not modify the steps of the method nor the structure of the system. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

Furthermore, it is old and well known to include all kinds of information in the parameter when making reservations, such as smoking preferences, seating

preferences on the airline, whether hotels allow pets, whether they have swimming pools, or conference rooms, etc.

There for it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the data indicating whether children are allowed so that families with children will know not to book with hotels and restaurants that do not allow children and people who do not have children and prefer not to be around children can book at a hotel or restaurant that does not allow children.

Referring to Claims 5 and 17:

Jones discloses generating a travel itinerary, including flight information, hotel information and ground transportation [0007]. Jones does not disclose a method and system wherein said listing indicates unavailability information associated with the travel arrangement, said unavailability information including dates of unavailability.

However, Among discloses a method and system wherein the packaging mechanism checks for availability and unavailability of inventory and wherein a third party can adjust availability and price of said options in accordance with inventory levels ([0021] an inventory monitor that classifies said at least one suboption as one of available and unavailable [0022] adjust availability and price of the plurality of options in accordance with inventory levels [0039] vendors may close out certain dates that are not available for sale by clicking on a specific date on a calendar displayed on the vendor interface, close out a specified range of dates, or offer a “block” of rooms at a certain price).

Furthermore, it is old and well known for resort or reservation information to provide dates of unavailability or dates of reduced rates or dates when rates do not apply when providing information to a customer. For example, during the summer months, rates at beach resorts are higher than during the winter months. If a resort routinely handles a conference or event, then the resort will be unavailable to book reservations at that time if all of the rooms have been reserved. Reservation information, such as advertisements, brochures, etc. often provide this information along with pictures of the resort, cabin, etc and prices and other information. The information is usually presented with a disclaimer that rates will not apply during certain time periods or during certain times of the year.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventory monitoring taught by Among with the travel planning disclosure of Jones so as to prevent considering a booking for a reservation that is not available.

Referring to Claims 6 and 18:

Jones discloses a method and system that shows available flights and their times and flights. Neither Jones nor Among disclose a method and system wherein said pricing information associated with the one or more categories of airfare is provided without regard to availability of seating.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the travel planning disclosure of Jones and the inventory packaging of Among the ability to provide pricing information without regard to

airfare so as to allow a user to obtain a sense of the market prior to beginning the process of making travel arrangements or planning for a vacation.

Furthermore, the data in the listing is determined to be non-functional descriptive data, not structurally related to the steps or the structure. The type data in the listing does not alter how the steps of the method are performed or the structure of the system. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

Referring to Claims 7 and 19:

Jones discloses a method or system further comprising accessing an associated computer network to determine the availability of seating after selection of a listed travel arrangement [0044-0045] the user may selected a preferred flight and seat, Figure 3C shows a picture of the plane so that the user may select a set).

Referring to Claims 8 and 20:

Jones discloses a method and system wherein said method further comprises displaying one or more flight options after the associated computer network is accessed (Figure 3A (340), Figure 8B, Figure 8D [0041-0045])

Referring to Claims 9 and 21:

Jones discloses a method and system wherein said displayed one or more flight options includes an indication a limited flight availability (Fig. 3B) Available Flights).

Referring to Claims 10 and 22:

Jones discloses a method or system wherein the method and system further comprises displaying price information (Figure 3B) and different price information associated with the number of persons (Figure 8B adjustments to fare for number of persons).

Jones does not disclose adjusted price information associated with the travel arrangements.

However, Among discloses a method and system further comprises displaying price information and adjusted price information associated with the travel arrangements (Figure 4 (407) Special pricing- rate is automatically applied [0045] [0052])

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the adjustments taught in Among with the travel planning disclosure of Jones so as to allow the user to see the saving from any special rate adjustment, to provide information on commission payment, and to provide a comparison for the user as to alternative options, i.e., whether using a travel agent increases the cost and if so, by how much.

Referring to Claims 11 and 23:

Jones discloses a method and system wherein said travel parameters include departure date and departure location, wherein dates associated with the airfare are determined in accordance with the departure date and departure location ([0039]).

Referring to Claims 12 and 24:

Jones discloses a method and system further comprising generating a confirmed travel arrangement without receipt of payment for the travel arrangement (Figure 7, [0056]).

Referring to Claims 25-27:

Jones discloses a system with a first data processing system (travel computer (120), data processing system (50)) for receiving travel parameters and generating a listing (itinerary) [0033-0039], a database for storing a plurality of travel arrangements (140), a polling computer (114) for transferring data to a central reservation system (130) (CRS) [0037] and a flight data server (116) ([0034-37] the travel system 114 include an air transportation subsystem (ATS) 116).

Referring to Claim 28:

Jones discloses a method for making travel arrangements upon request by a user of a computer network, the method comprising:

receiving travel parameters associated with a desired travel option (*Figure 2A (200) Receive Trip Parameters [0031], [0039] travel parameters include..*);

generating a listing of one or more travel arrangements in accordance with the travel parameters (*[0030-0031]; Figure 7 (700) review itinerary [0056]*, said listing including pricing information associated with the travel parameters (*Figure 3B Available flights on 9/7 and prices shown, [0045] Fig. 3b also shows available flights and their times and prices, (Figure 8B) the Fare for this itinerary is \$578 per person, \$1156 for 2 passengers*); and

displaying the listing of the one or more travel arrangements (*[0031] the travel system sends display data to a display located at the user's site for displaying travel options, [0045]* Figures 3b-3c show example screen displays presented on display 106, Figure 7 (700) and [0056] Once the itinerary is complete, RCS 128 sends display data to presentation program 108 which in turn displays the itinerary for the user to review (step 700); Figure 8B and Figure 8D).

generating a confirmed travel arrangement without receipt of payment for the travel arrangement, the confirmed travel arrangement including information relation to a net amount of money due from the user, (*Figure 7 (700) [0056] once an itinerary is complete, RCS 128 sends display data to presentation program 108 which in turn display the itinerary for the user to review, Figure 3B*).

Jones does not disclose determining whether the user is a direct customer or a travel agent or forwarding, to a tour operator's reservation system, the confirmed travel arrangements or wherein, when the user is a travel agent, the amount of money due is reduced by an amount of an agency commission.

However, Among discloses a step of determining (*login*) who the user is, determining if a passenger is identified as qualified for special pricing and automatically applying a rate if qualified (*Figure 4 step 407 If passenger identified as qualified for special pricing – rate is automatically applied*), a customer information database (106) which includes client and customer information and identification [0039], allowing for tracking of sales by an individual or by an entity, sending confirmation messages to travel agent 605 and the buyer (606) and the ability to enroll online in an incentive

program and receive special access to the site via the login and password which includes a travel agent [0052] (*Figure 1 (102)(101) login, Figure 3 (300) customer inputs: resident state, name, other login information; page 5 [0052]*).

Among further discloses in addition to sending confirmation to the vendors 602, a confirmation message is also sent to any travel agent 606 that booked the package and to the buyer [0051].

Among discloses an invention wherein the travel agents can manage commission payment [0052].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the login teachings of Among with travel planning disclosure of Jones since, by identifying the user, the travel planning method and system of Jones would have access to information about special pricing, incentives, and commission payments that may be available to the user, thus allowing for the user to receive the special pricing, and also allowing for the tracing of sales by an individual or by an entity which would aid travel agents in managing commission payments. .

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine sending a confirmation message to any travel agent, vendor or buyer taught in Among with the travel planning disclosed in Jones for the purpose of providing verification that the reservation was made.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the commission payment taught in Among with the travel

planning disclosed in Jones to allow for travel agents to manage and receive their commission payments and for the tracking and reporting of sales.

Furthermore, the fact that the user is a direct user or a travel agent in the claim language above is determined to be non-functional descriptive data, not structurally related to the steps or the structure. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

#### **(10) Response to Argument**

##### **A. Summary of Arguments**

###### **1. Rejection of claims 1-12 and 25-26 under 35 USC Section 102(b) as being anticipated by Lynch.**

The appellant argues that Lynch fails to disclose at least the claimed feature of means for determining whether the user is a direct customer or a travel agent. The Examiner respectfully disagrees with this assertion.

Lynch discloses that system 10, under the control of decision engine module 16, **determines the identify of the traveler, the business entity which employs the traveler, and the travel agency of which the individual is a customer** (Figure 1 Decision Engine (16) Fig. 3 (106) Determine traveler, Business Entity and Agency Association, column 5, lines 31-35 – at block 106, in response to the travel request information, system 10 under the control of decision engine module 16 determines the

*identity of the traveler, the business entity which employs the traveler (if applicable), and the travel agency of which the individual is a customer (if applicable).*

Appellant admits that in step 106 the system of Lynch determines the traveler, business entity and agency association (page 18, last paragraph). The appellant argues that the system never states that the user is a direct customer or a travel agency. Appellant then states that each of independent claims 1 and 25 recite the feature of determining whether the user is a direct customer or a travel agent, and that Lynch does not disclose this. Appellant states that Lynch *presumes* that the user is a travel agent and that the traveler is associated with the travel agent, instead of determining whether the user is a direct customer or a travel agent.

The Examiner asserts that all the claim language requires is a means for determining whether the user is a direct customer or a travel agent. Lynch discloses a system with a means for identifying a traveler, the business entity which employs the traveler, and the travel agency of which the individual is a customer. Furthermore, given the broadest reasonable interpretation of a direct customer, can a travel agent not be a direct customer?

**2. Rejection of claims 1-28 under 35 USC section 103(a) as being unpatentable over Jones in view of Among.**

Claims 1-12 and 25-27 are rejected in the alternative under 35 USC 103(a) as being unpatentable over Jones in view of Among.

Appellant argues that Among does not disclose determining whether the user is a direct customer or a travel agent. The Examiner respectfully disagrees with this assertion.

Among discloses a step of determining (*login*) who the user is, determining if a passenger is identified as qualified for special pricing and automatically applying a rate if qualified (Figure 4 step 407 If passenger identified as qualified for special pricing – rate is automatically applied), a customer information database (106) which includes client and customer information and identification [0039], allowing for tracking of sales by an individual or by an entity, sending confirmation messages to travel agent 605 and the buyer (606) and the ability to enroll online in an incentive program and receive special access to the site via the login and password which includes a travel agent [0052] (*Figure 1 (102)(101) login, Figure 3 (300) customer inputs: resident state, name, other login information; page 5 [0052]*).

Furthermore, the Examiner asserts that the fact that the user is a direct user or a travel agent, as claimed in the body of the claim, is determined to be non-functional descriptive data, not structurally related to the steps or the structure. Once the user is identified, this information is not used in the claim language. Thus, all that the prior art reference need to disclose or teach is a means for identifying the user or the step of identifying the user. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

The appellant asserts that the Examiner has made no showing, whatsoever, of a motivation to combine.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in the secondary (Among) reference in paragraph [0052].

**B. Rejection of claims 1-12 and 25-27 under 35 USC as being anticipated by Lynch.**

Appellant argues that Lynch fails to disclose the claimed feature of a means for determining whether the user is a direct customer or a travel agent.

**1. The Lynch Patent**

The appellant states that the Lynch patent, as understood by appellant, is directed to an automated travel planning system with a database that stores information relating to each individual traveler and business entity customer of a travel agency and information relating to the travel agency itself. The Examiner agrees with this assertion. Figure 1 shows a Traveler Portfolio (18), a Business Entity Portfolio (20) and a Travel Agency Portfolio (22). The appellant then cites the abstract of the patent as stating that this information may include, for example, smoking and seating preferences for a

traveler, preferred travel vendors of a business entity, restrictions on fare classes (e.g., business or coach classes only) imposed by a business entity on its employees, and promotions available to a travel agency. Appellant goes on to cite the abstract stating that when travel request information is received from a specific customer (individual and/or business entity) of the travel agency, the system automatically retrieves information relating to the customer from the database and also information relating to the travel agency. The system of Lynch preferably users the retrieved information to determine a travel plan that is satisfactory to the individual customer who is traveling, the business traveler customer which employees the individual and the travel agency. The appellant then states that Lynch fails to disclose determination of whether the user is a direct customer or a travel agent.

2. Lynch Fails to Disclose Determination of Whether User is a Direct customer or a Travel Agent of Independent Claims 1 and 25.

The appellant argues that Lynch fails to disclose the claimed feature of the means for determining whether the user is a direct customer or a travel agent.

Referring to Claim 1:

Claim 1 is a reservation **system** for making travel arrangements upon the request by a user, the system comprising:

***means for determining whether the user is a direct customer or a travel agent,***

***means for receiving travel parameters associated with a desired travel option;***

***means for generating a listing*** of one or more travel arrangements in accordance with the travel parameters, said listing including pricing information associated with each respective travel arrangement; and

***means for displaying the listing*** of the one or more travel arrangements.

Appellant states that the feature of determining whether the user is a direct customer or a travel agent provides the invention with the advantage that the reservation system ***can tailor the information to be provided in the listing based on whether the user is a direct customer or a travel agent*** (page 11 of the appeal brief, last paragraph). In response to this argument, it is noted that the features upon which appellant relies (i.e., tailoring the information to be provided in the listing based on whether the user is a direct customer or a travel agent) are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). For the appellant's invention to encompass tailoring the information provided in the listing based on whether the user is a direct customer or a travel agent, the appellant must incorporate this into the claim language. There is nothing in the claim language that suggest that the information that the user is a direct customer or a travel agent is used in the generation of the list. The claim language has the list generated in accordance with the travel parameters. The travel parameters are associated with the desired travel option. The appellant never uses the information of whether the user is a direct customer or travel agent in the claim language to generate the list.

Appellant goes on to state that the feature of determining whether the user is a direct customer or a travel agent enables the reservation system to take into account whether or not an agency commission will be paid. The appellant states that there may be other travel parameters whose price or availability may depend on whether the user is a direct customer or a travel agent. For example, the appellant states that there may be certain travel arrangements that will not afford an agency commission, so the pricing information provided to the user may be affected by whether or not the user is a travel agency.

However, claim 1 identifies an invention that has a means for determining whether the user is a direct customer or a travel agent, means for receiving travel parameters, means for generating a listing of the travel arrangements in accordance with the travel parameters, and a means for displaying the listing. Claim 1 is directed to a system. The claim limitation of said listing including pricing information associated with each respective travel arrangement is not a structural limitation. It further identifies the listing. Appellant has not positively claimed a limitation providing for the price or availability being linked to whether the user is a direct customer or a travel agent.

The Examiner asserts that Lynch discloses a means for determining whether the user is a direct customer or a travel agent (*Figure 1 Decision Engine (16), Traveler Portfolio (18), Business Entity Portfolio (20), Travel Agency Portfolio (22); Fig. 3 (106) Determine traveler, Business Entity and Agency Association, column 5, lines 31-35 – at block 106, in response to the travel request information, system 10 under the control of decision engine module 16 determines the identity of the traveler, the business*

***entity which employs the traveler (if applicable), and the travel agency of which the individual is a customer (if applicable).***

The appellant states on page 13 of the appeal brief, that the Lynch system presumes that the traveler is associated with a business entity and then, and only then does the Lynch system start differentiating the requirements of the user, business entity and travel agency. The Examiner disagrees with this analysis of Lynch. Figure 3, steps (102, 104 and 106), show the system receiving travel request information, and at step (106) determining traveler, business entity and agency association.

Lynch, column 3, lines 12-21, discloses:

Processing network 12 functions to run one or more software applications or modules, which can include a decision engine module 16. Decision engine module 16 functions to receive travel request information, ***such as a travel itinerary, input into system 10 and, in response, determines a preferred travel plan for each of a traveler, a business entity employing the traveler (if applicable), and the travel agency.***

As for appellant's argument that there is no suggestion in Lynch that there is ever the case that an individual can use the Lynch system without the assistance of a travel agent, the Examiner directs the appellant to column 4, lines 57-58, wherein Lynch discloses that a user of system 10, ***such as a travel agent,*** may input and receive travel-and-customer related information). The language, such as a travel agent, indicates that the user could be someone other than a travel agent, such as a traveler. Moreover, it is not clear why a travel agent could not also be considered to be a direct customer. Even if Lynch did disclose that an individual can only use the Lynch system with the assistance of a travel agent as appellant asserts, all that claim 1 requires is that there be a means for determining whether the user is a direct customer or a travel

agent. The Examiner asserts that Lynch has the means for making this determination. Furthermore, the appellant's claim language does not preclude any or all of the transaction steps from being made with the assistance of a travel agent.

The Examiner notes that the appellant states that Lynch fails to disclose the claimed feature of *means for determining whether the user is a direct customer or a travel agent*, as recited in independent claims 1, 13, and 25. The Examiner makes note that claim 13 has not been rejected using Lynch as the prior art. Claim 13 is directed to a method, while claims 1 and 25 are directed to systems. Thus, claim 13 has been addressed in a separate rejection.

Appellant then argues that Lynch fails to disclose a listing of one or more travel arrangements in accordance with the travel parameters, said listing including pricing information.

First, the appellant is reminded that claims 1 and 25 are directed to a system. Therefore, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus/system must be distinguished from the prior art in terms of structure rather than function.

Lynch discloses a means for generating a listing of one or more travel arrangements in accordance with the travel parameters (*Decision engine module (16) - col. 3, lines 16-21 Decision engine module 16 functions to receive travel request information, such as a travel itinerary, input into system 10 and, in response, determines a preferred travel plan*). Given the broadest reasonable interpretation, the Examiner interprets a travel itinerary as a listing of one or more travel arrangements in

accordance with travel parameters. The fact that the listing includes pricing information would be considered non-functional descriptive data that is not structurally related to the system. The structure of the system would be the same regardless of whether the listing is called a listing or an itinerary or whether the listing includes pricing information. Lynch has a means for generating a listing/itinerary and a means for displaying the listing. The data in the listing is non-functional descriptive data. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

Lynch discloses the following:

System 10 receives information relating to an incoming travel request from a customer. Typically, this travel request information includes a general travel itinerary outlining various minimum parameters for travel, such as, for example, times/dates of travel and the type(s) of travel services required. In response to the travel request information, system 10 **determines a recommended travel plan or policy that balances between the preferences of the individual traveler, a business entity employing the traveler (if applicable), and the travel agency.** The travel plan can be used as a guideline to book travel arrangements that fall within the parameters of the travel itinerary (column 4, lines 13-24).

Again on page 13 of the appellant's appeal brief, appellant makes reference to claim 13. Lynch has not been used as prior art to reject claim 13. Claim 13 is directed to a method and has been addressed in a separate rejection.

3. Lynch Fails to Disclose the Travel Parameters of Dependent Claims 2, 4-6, and 11.

As for appellant's arguments as to claims 2, 4-6 and 11, the Examiner disagrees with the appellant's position that the data in the claim language defines structure.

Claims 2, 4-6 and 11 are directed to the listing, the travel parameters, and the pricing information. While Lynch discloses the travel request information including, for example, the name of a customer (individual and/or business entity), the time and dates of travel and types of travel services needed (e.g., airline flight, hotel automobile rental, etc.), Lynch does not explicitly disclose a system wherein the listing includes a plurality of room accommodations and pricing information, wherein said listing includes information relating to whether children are allowed, wherein said listing indicates unavailability information, or wherein pricing information is provided. However, as stated in the rejection above, Lynch displays listings in the form of itineraries. Claims 2, 4-6 and 11 further identify the listing, the travel parameters and the pricing information, not the structure of the system. The data displayed in the listings, the travel parameters and the pricing information is determined to be non-functional descriptive data, not functionally interrelated with the structure of the system. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

Furthermore, an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114). The system in Lynch is fully capable of processing and displaying a listing, travel parameters and pricing information. For example, Lynch discloses at column 4, lines 14-23:

**Typically**, this travel request information includes a general travel itinerary outlining **various minimum parameters for travel, such as, for example**, times/dates of travel and the type(s) of travel services required. In response to the travel request information, system 10 determines a recommended travel plan

or policy that balances between the preferences of the individual traveler, a business entity employing the traveler (if applicable), and the travel agency.

The language *the travel request information can include, for example,* indicates that the listing of travel parameters is not all inclusive. The system of Lynch is fully capable of displaying travel parameters, listings, and pricing information.

**NOTE:** On page 19 of the appeal brief, appellant argues claim 27, even though this has not been identified under the heading of the arguments being addressed in this section. The heading indicates that appellant is arguing claims 2, 4-6 and 11.

As for appellant's arguments that Lynch does not disclose second and third data processing systems, wherein the second data processing system is a central reservation system and the third data processing is a flight data server, the appellant is directed to col. 3, lines 12-14. Lynch discloses that processing network 12 may consist of a plurality of interconnected processors. See the discussion below as to claims 25 and 27.

**4. Lynch Fails to Fully Disclose Means for Displaying as Recited in Claims 3 and 8-10:**

Claims 3 and 8-10 are directed to a means for displaying. The appellant asserts that Lynch fails to fully disclose a means for displaying as recited in claims 3 and 8-10. Claim 3 is directed to a means for displaying images associated with the plurality of room accommodations, in response to selection of the room accommodations, claims 8 and 9 are directed to a means for displaying one or more flight options, and claim 10 is a means for displaying pricing information.

Since appellant's invention is directed to a computer reservation system comprising one or more personal computers, as shown in Figure 12, the means for displaying would be a graphical user interface as shown in Lynch, Figure 2 (34). The Examiner asserts that the fact that the means for displaying displays images associated with a plurality of room accommodations or flight options, or an indication of a limited flight availability is data that is deemed non-functional descriptive data, not functionally interrelated with the structure of the system. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

Furthermore, an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114). The system of Lynch is fully capable of displaying images and flight options in the travel plan that the system 10 generates.

##### 5. Lynch Fails to Disclose a Database for Storing a Plurality of Travel Arrangements and Other Features of Claim 25.

Claim 25 is directed to a reservation **system** for making travel arrangements comprising a first data processing system, and at least one database for storing a plurality of travel arrangements and the associated pricing information.

The Examiner rejected claim 25 as follows:

Lynch discloses a reservation **system** making travel arrangements comprising: **first data processing system** (*Processing network 12*) for determining whether the user is a direct customer or a travel agent ((*Figure 1 Decision Engine (16) Fig. 3*

*(106) Determine traveler, Business Entity and Agency Association, column 5, lines 31-35 – at block 106, in response to the travel request information, system 10 under the control of decision engine module 16 determines the identity of the traveler, the business entity which employs the traveler (if applicable), and the travel agency of which the individual is a customer (if applicable); receiving travel parameters associated with a desired travel option and generating a listing in accordance with the parameters and displaying the listing of the one or more travel arrangements (col. 3, lines 12-21 decision engine module 16 functions to receive travel request information, such as travel itinerary, input into system 10 and, in response determines a preferred travel plan; col. 4, lines 57-61 a user of system 10 may input and receive travel and customer elated information (including the travel plan generated by the system 10 through any of the workstations 34); and*

*at least one database* (Figure 1 (14) and col. 3, lines 31-37 and data storage device 28 col. 4, line 66 thru col. 5, line 7).

The language *for storing a plurality of the travel arrangements and the associated pricing information* is the intended use of the structure and does not distinguish the claimed apparatus from the prior art since the databases of Lynch store information relating to travel preferences and are fully capable of storing travel arrangements and pricing information.

The appellant asserts that there is no anticipation of claim 25 because Lynch does not disclose that the database are for storing a plurality of the travel arrangements and the associated pricing information.

MPEP 2106 states as follows:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

## MPEP Section 2114

### 2114 Apparatus and Article Claims — Functional Language

For a discussion of case law which provides guidance in interpreting the functional portion of means-plus-function limitations see MPEP § 2181 - § 2186.

### APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

### MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART

A claim containing a "recitation with respect to the manner in which a claimed apparatus is *intended to be employed* does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the

structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was “for mixing flowing developer material” and the body of the claim recited “means for mixing ...., said mixing means being stationary and completely submerged in the developer material”. The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.).

#### A PRIOR ART DEVICE CAN PERFORM ALL THE FUNCTIONS OF THE APPARATUS CLAIM AND STILL NOT ANTICIPATE THE CLAIM

Even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim *if there is any structural difference*. It should be noted, however, that means plus function limitations are met by structures which are equivalent to the corresponding structures recited in the specification. *In re Ruskin*, 347 F.2d 843, 146 USPQ 211 (CCPA 1965) as implicitly modified by *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994). See also *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.)

Appellant has not identified any structural difference between appellant’s database and the prior art database. The fact that the database is *for storing a plurality of the travel arrangements and the associated pricing information* is language defining how the database is to be employed. The intended use of the structure does not distinguish the claimed apparatus from the prior art since the databases disclosed in Lynch store information relating to travel preferences and are fully capable of storing travel arrangements and pricing information.

#### 6. Lynch Fails to Disclose a Second Data Processing System being a Central Reservation System and Other Features of Claim 27.

Lynch discloses an automated travel planning system 10 which includes a processing network 12 connected to a database 14. Processing network 12 may consist of a single processor or, as described below with reference to Figure 2, a plurality of interconnected processors. Processing network 12 functions to run one or more software applications or modules which can include a decision engine module 16 – decision engine module 16 functions to receive travel request information input into system 10 and, in response, determines a preferred travel plan for each traveler (col. 3, lines 12-15 – Processing network 12 may consist of a plurality of interconnected processors). The fact that the second data processing system is identified as a central reservation system and the third data processing system is a flight data server, as claimed, is non-functional descriptive data, not structurally related to the structure. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

7. Appellants' Response to the Examiner's Assertion Regarding the Scope of the Appellants' Claimed Invention.

The appellant states that the feature of determining whether the user is a direct customer or a travel agent provides the invention with the advantage that the reservation system can tailor the information to be provided in the listing based on whether the user is a direct customer or a travel agent. The Examiner asserts that for the appellant's invention to be able to tailor the information to be provided in the listing based on whether the user is a direct customer or a travel agent, the appellant must

incorporate the tailoring with the determination of whether the user is a direct customer or a travel agent into the claim language. There is nothing in the claim language that suggest that the information that the user is a direct customer or a travel agent is used in the generation of the list. The claim language has the list generated in accordance with the travel parameters. The travel parameters are associated with the desired travel option. The appellant never uses the information of whether the user is a direct customer or travel agent in the claim language to generate the list.

The appellant states on page 21 of the appeal brief that the Examiner misses the point of appellant's discussion. The appellant states that appellant never asserted that the advantage of tailoring the information to be provided in the listing based on whether the user is a direct customer or a travel agent is a recited claim feature. Appellant states that instead, appellant's argument is that the recited claim feature of determining whether the user is a direct customer or a travel agent provides the invention with the tailoring advantage. Appellant then states that appellant has now demonstrated why the recited claim feature is an important aspect of the invention, thereby patentably distinguishing it from the prior art.

Appellant is reminded that claims must be given their broadest reasonable interpretation consistent with the supporting description without reading limitations into the claim (MPEP 2111). Therefore, giving claims 1 and 25 the broadest reasonable interpretation, appellant is claiming a means for determining the identity of the user, i.e., whether the user is a direct customer or a travel agent.

Lynch discloses that system 10, under the control of decision engine module 16, determines the identify of the traveler, the business entity which employs the traveler, and the travel agency of which the individual is a customer (*Figure 1 Decision Engine (16) Fig. 3 (106) Determine traveler, Business Entity and Agency Association, column 5, lines 31-35 – at block 106, in response to the travel request information, system 10 under the control of decision engine module 16 determines the identity of the traveler, the business entity which employs the traveler (if applicable), and the travel agency of which the individual is a customer (if applicable).*

Appellant admits that in step 106 the system of Lynch determines the traveler, business entity and agency association (page 18, last paragraph of the Response submitted on October 25, 2005). The appellant argues that the system of Lynch never states that the user is a direct customer or a travel agency. Appellant then states that because each of independent claims 1 and 25 recite the feature of determining whether the user is a direct customer or a travel agent, and because Lynch does not disclose this, appellant submits that each of these claims is allowable over Lynch. The Examiner respectfully disagrees with this argument.

The Examiner asserts that given the broadest reasonable interpretation of a direct customer, can a traveler not be a direct customer? Can a travel agent not be a direct customer? Furthermore, the Examiner asserts that Lynch does disclose a means for determining the identity of the traveler as set forth above. Any advantage that appellant asserts flows from this determination step has not been recited in the claim language. For the determination to provide the invention with the tailoring advantage,

the determination must then be used in the body of the claims in the generation of the listing and the generation of the pricing information.

8. Appellant's Responses to the Examiner's Assertion Regarding the Use or Non-Use of a Travel Agent to Make Travel Transactions.

As for appellant's argument that there is no suggestion in Lynch to suggest that there is ever the case that an individual can use the Lynch system without the assistance of a travel agent, the Examiner directs the appellant to column 4, lines 57-58, wherein Lynch discloses that a user of system 10, ***such as a travel agent***, may input and receive travel-and-customer related information). The language, such as a travel agent, indicates that the user could be someone other than a travel agent, such as a traveler. Moreover, it is not clear why a travel agent could not also be considered to be a direct customer. Even if Lynch did disclose that an individual can only use the Lynch system with the assistance of a travel agent as appellant asserts, all that claim 1 requires is that there be a means for determining whether the user is a direct customer or a travel agent. The Examiner asserts that Lynch has the means for making this determination. Furthermore, the appellant's claim language does not preclude any or all of the transaction steps from being made with the assistance of a travel agent.

C. Rejection of Claims 1-28 Under 35 USC Section 103(a) as Allegedly Being Unpatentable Over Jones In View of Among.

1. The Among Patent

The appellant has extracted parts from the abstract to identify what appellant submits Among discloses.

## 2. The Jones Patent

The appellant has extracted parts from the abstract to identify what appellant submits Among discloses.

## 3. The Motivation to Combine Jones and Among is Legally Insufficient for Claims 1-27.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in the secondary (Among) reference [0052].

The appellant states that the Examiner merely repeats the advantages that the appellant themselves have already previously presented in their specification. However, paragraph [52] of the Among reference provided the Examiner's motivation to combine. Thus, the Examiner found the teaching or suggestion to the claimed combination in the prior art reference, not the appellant's disclosure.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The appellant's argues that the combination renders the prior art unsatisfactory for its intended purpose. It has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Among is in the appellant's field of endeavor, reservations, and Among is pertinent to the particular problem with which the appellant is concerned, determining the identify of the user making the reservation. Among then uses the identification of the user to identify special pricing, incentives and commission payments related to the user.

It is not clear how combining Jones and Among would change the principles of operation of Jones as asserted by the appellant. Appellant states that Jones is a goal oriented travel planning system and the combination would change the principle operation to an incentive based travel system that can determine whether the user is a direct customer or a travel agent. Jones is a travel system for processing travel request based on the travel parameters input by the user [0039]. Information is presented to the user that is tailored to the user's travel plans [0030], after receiving the travel parameters. The system then invokes subsystem 116 to select flights or flights and

prices [0040]. Among discloses a step of determining (*login*) who the user is, determining if a passenger is identified as qualified for special pricing and automatically applying a rate if qualified (Figure 4 step 407 If passenger identified as qualified for special pricing – rate is automatically applied), a customer information database (106) which includes client and customer information and identification [0039], allowing for tracking of sales by an individual or by an entity, sending confirmation messages to travel agent 605 and the buyer (606) and the ability to enroll online in an incentive program and receive special access to the site via the login and password which includes a travel agent [0052] (*Figure 1 (102)(101) login, Figure 3 (300) customer inputs: resident state, name, other login information; page 5 [0052]*). Thus, Jones in combination with Among allows for the processing of travel request based on travel parameters input by a user and any pricing information presented to the user would have automatically applied any special pricing rate.

4. The Combination of Jones and Among Fails to Disclose Determination of Whether a User is a Direct Customer or a Travel Agent of Independent Claims 1 and 13:

Appellant argues Among does not disclose determining whether the user is a direct customer or a travel agent. The Examiner respectfully disagrees.

First, the Examiner directs the Board to the statement on page 25 of the appellant's appeal brief wherein appellant states that combining Jones and Among would change the principle of operation of Jones from being a goal oriented travel planning system for a user *to an incentive based travel system that can determine*

***whether the user is a direct customer or a travel agent.*** The Examiner takes this as an admission by appellant that Among discloses determining whether the user is a direct customer or a travel agent.

As discussed in the rejection above, Among discloses a step and structure for determining (*login*) who the user is, determining if a passenger is identified as qualified for special pricing and automatically applying a rate if qualified (Figure 4 step 407 If passenger identified as qualified for special pricing – rate is automatically applied), a customer information database (106) which includes client and customer information and identification [0039], allowing for tracking of sales by an individual or by an entity, sending confirmation messages to travel agent 605 and the buyer (606) and the ability to enroll online in an incentive program and receive special access to the site via the login and password which includes a travel agent [0052] (*Figure 1 (102)(101) login, Figure 3 (300) customer inputs: resident state, name, other login information; page 5 [0052]*).

Furthermore, the Examiner asserts that the fact that the user is a direct user or a travel agent, as claimed in the body of the claims, is determined to be non-functional descriptive data, not structurally related to the steps or the structure. Once the user is identified, this information is not used in the claim language. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

Moreover, a login is a form of gaining access to a specific computer, a program, or a network by identifying oneself with a username and a password. Thus, each time one logs into a system, the system identifies the person logging in, whether it be a direct customer or a travel agent.

5. The Combination of Jones and Among Fails to Disclose All of the Claimed Features of Dependent Claims 2-12 and 14-24.

a. Dependent Claims 2 and 14.

Jones discloses the listing including the following information:

a plurality of room accommodations, pricing information for the plurality of room accommodations. (Fig. 2A (230) Invoke Hotel Decision Support System, Fig. 4A (400) Hotel subsystem, [0008] traveler's itinerary is generated interactively with a user by selecting hotels [0030] the system generates the itinerary interactively with a user by selecting flights, hotels, ground transportation, and Figure 4B \$217.00 per night (price) and [0047] Fig. 4a is a flow chart of the steps performed by the hotel subsystem 1888. HS 118 recommends hotels).

Jones does not disclose the pricing information for the plurality of room accommodations displayed *with one or more categories of airfare*. The Examiner is reading this to mean that the component prices of a package are shown, e.g., a total package price includes the cost of a room at a certain dollar amount and the cost of a flight at a specified dollar amount.

Among discloses the individual package component prices (Fig. 4 (401-406) which includes airline price data and hotel (accommodation) price data [0045] after the

buyer has provided parameter information for components 400 and selected desired components 401, suboptions are generated and priced by the server 105 for selected components from the airline, hotel, car and other travel products/services price database).

The Examiner does not agree with the appellant's assertion that only a complete package price is returned in Among. Figure 4, steps 401-405, shows the buyer selecting desired components with the airline price data (402) shown with the hotel price data (403). Furthermore, an interpretation of the claim language, *one or more categories of pricing information*, means that only one airfare need be included in the listing.

The Examiner asserts that the language stating that the listing includes a plurality of room accommodations, pricing information for the plurality of room accommodations, and pricing information for the plurality of room accommodations with one or more categories of airfare, is non-functional descriptive data, not structurally related to the steps or the structure. The information included in the listing is not used in the claim language. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

b. Dependent Claims 4 and 16.

Jones discloses travel parameters including accommodation name, arrival date, departure date, departure location, and number of guests (Fig. 4A (400) Profile,

Proximity to destination, [0030-0031] a user only need to input a goal, including a destination and time to be at the destination; destination time, site, and an origination site [0039] origination airport, origination city, arrival date and time, duration, required return time).

The Examiner asserts that the language stating that *the travel parameter includes whether children are allowed* is non-functional descriptive data, not functionally related to the steps or method. This data does not modify the steps of the method nor the structure of the system. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

Furthermore, the Examiner asserts that it is old and well known to include all kinds of information in the parameter when making reservations, such as smoking preferences, seating preferences on the airline, whether hotels allow pets, whether they have swimming pools, or conference rooms, etc.

c. Dependent Claims 6 and 18.

Claims 6 and 18 are directed to the pricing information associated with the one or more categories of airfare being provided without regard to availability of seating.

Jones discloses shows available flights and their times and flights (Figure 3B). Neither Jones nor Among disclose wherein said pricing information associated with the one or more categories of airfare is provided *without regard to availability of seating*.

However, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the travel planning disclosure of Jones and the inventory packaging of Among the ability to provide pricing information without regard to airfare so as to allow a user to obtain a sense of the market prior to beginning the process of making travel arrangements or planning for a vacation.

The Examiner also asserts that the pricing information is data that is contained in the listing of travel arrangements generated in accordance with the travel parameters. The fact that the pricing data contained in the listing is determined without regard to availability of seating is non-functional descriptive data, not structurally related to the steps or the structure. The type data in the listing does not alter how the steps of the method are performed or the structure of the system. Furthermore, the fact that the pricing information was provided without regard to the availability of seating does not alter how the steps of the method are performed or the structure of the system. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

d. Dependent Claims 7 and 19.

Claims 7 and 19 are directed to a means for and a step of accessing an associated computer to determine the availability of seating, after the selection of a listed travel arrangement.

Jones discloses a means and a step of accessing an associated computer network to determine the availability of seating after selection of a listed travel arrangement ([0044-0045] the user may selected a preferred flight and seat, Figure 3C shows a picture of the plane so that the user may select a set).

e. Dependent Claim 12 and 24:

Claims 12 and 24 are directed to a means for and a step of generating a confirmed travel arrangement without receipt of payment for the travel arrangement, the confirmed travel arrangement including information relating to net amount of money due from the user, and wherein when the user is a travel agent, the net amount of money due is reduced by an amount of an agency commission.

Jones discloses a means for and a step of generating a confirmed travel arrangement without receipt of payment for the travel arrangement (Figure 7, Reservation confirmation system, review itinerary (700), acceptable (710), deliver, print, email or fax itinerary (730); and paragraph [0056]). There is no payment shown in Figure 7. Thus, it can be assumed that the travel arrangement was generated without receipt of payment. Claim 24 is directed to the confirmed travel arrangement including information relating to the amount due from the user. The Examiner interprets this to be the price of the travel arrangement. Figure 3B shows the prices of the reservations that are available for the user to reserve. Once reserved the Reservation Confirmation System would review the itinerary and deliver, print, email or fax the itinerary. There has been no disclosure of payment.

The appellant then claims that wherein when the user is a travel agent, the net amount of money due is reduced by an amount of an agency commission. Among discloses individual package component prices are complied (Figure 4 (406) and that if the passenger is identified as qualified for special pricing-rate, this is automatically applied (Figure 4 (407). Among also discloses that travel agents can manage pending reservations and commission payments [0052]. The Examiner asserts that prices disclosed in Among would have reduced the net amount of money due by the amount of an agency commission so that the purchaser is not charged more for going through a travel agent since the travel agent takes the amount of money due on a reservation and adds a commission payment. Thus, common sense dictates that it would be necessary for the net price presented to the travel agent to be reduced by the amount of the travel agent commission.

Claim 12 is directed to a system and a means for generating a confirmed travel arrangement. Jones discloses this means for generating in Figure 7 (RESERVATION CONFIRMATION SYSTEM). The type information on the travel arrangement and the fact that the confirmed travel arrangement is generated without receipt of payment is non-functional descriptive data, not structurally related to the structure. The type data in the travel arrangement does not alter how the structure of the system. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

6. The Combination of Jones and Among Fails to Disclose a First Data Processing system for Determining whether the User is a Direct Customer or a Travel Agent and Other Features of Claims 25-27.

Claim 25 is directed to a reservation system comprising a first data processing system and at least one database.

Jones discloses a system with a first data processing system (*travel computer* (120), *data processing system* (50)) for receiving travel parameters and generating a listing (*itinerary*) [0033-0039], a database for storing a plurality of travel arrangements (140).

Claim 26 is directed to a reservation system wherein the system further includes a polling computer and wherein the second data processing system is a central reservation system (CSR). Jones discloses a polling computer (114) for transferring data to a central reservation system (130) (CRS) [0037] and a flight data server (116) ([0034-37] the travel system 114 include an air transportation subsystem (ATS) 116).

The intended use of the structure will not distinguish the system over the prior art if the Examiner has reason to believe that the system of Jones is fully capable of performing the functions. An apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114). The system in Lynch is fully capable of processing, receiving, displaying and storing the type of data set forth in the claim language.

7. The Motivation to Combine Jones and Among is Legally Insufficient for Claim 28:

Appellant has failed to argue the rejection of claim 28. The Examiner will address this rejection to ensure completeness of this Examiner's Answer.

Claim 28 is directed to a method for making travel arrangements upon request by a user of a computer network, the method comprising:

receiving travel parameters associated with a desired travel option (Jones discloses in *Figure 2A (200) Receive Trip Parameters [0031], [0039] travel parameters include..*);

generating a listing of one or more travel arrangements in accordance with the travel parameters (Jones discloses [0030-0031]; *Figure 7 (700) review itinerary [0056]*, said listing including pricing information associated with the travel parameters (*Figure 3B Available flights on 9/7 and prices shown, [0045] Fig. 3b also shows available flights and their times and prices, (Figure 8B) the Fare for this itinerary is \$578 per person, \$1156 for 2 passengers*); and

displaying the listing of the one or more travel arrangements (Jones discloses [0031] *the travel system sends display data to a display located at the user's site for displaying travel options, [0045] Figures 3b-3c show example screen displays presented on display 106, Figure 7 (700) and [0056] Once the itinerary is complete, RCS 128 sends display data to presentation program 108 which in turn displays the itinerary for the user to review (step 700); Figure 8B and Figure 8D*).

generating a confirmed travel arrangement without receipt of payment for the travel arrangement, the confirmed travel arrangement including information relating to a net amount of money due from the user, ([0056] once an itinerary is complete, RCS 128 sends display data to presentation program 108 which in turn displays the itinerary for the user to review, Figure 3B (Figure 7, Reservation confirmation system, review itinerary (700), acceptable (710), deliver, print, email or fax itinerary (730); and paragraph [0056]).

There is no payment shown in Figure 7. Thus, it can be assumed that the travel arrangement was generated without receipt of payment. Claim 28 is directed to the confirmed travel arrangement including information relating to the amount due from user. The Examiner interprets this to be the price of the travel arrangement. Figure 3B shows the prices of the reservations that are available for the user to reserve. Once reserved, the Reservation Confirmation System would review the itinerary and deliver, print, email or fax the itinerary. There has been no disclosure of payment, thus the travel arrangement was generated without receipt of payment.

The appellant then claims that wherein when the user is a travel agent, the net amount of money due is reduced by an amount of an agency commission. Among discloses individual package component prices are compiled (Figure 4 (406) and that if the passenger is identified as qualified for special pricing-rate, this is automatically applied (Figure 4 (407). Among also discloses that travel agents can manage pending reservations and commission payments [0052]. The Examiner asserts that it would have been obvious to reduce the net amount of money due by the amount of an agency

commission so that the purchaser is not charged more by going through a travel agent because the travel agent takes the amount of money due and adds a commission payment. Thus, common sense dictates that it would be necessary for the net price presented to the travel agent to be reduced by the amount of the travel agent commission.

Jones does not disclose determining whether the user is a direct customer or a travel agent or forwarding, to a tour operator's reservation system, the confirmed travel arrangements or wherein, when the user is a travel agent, the amount of money due is reduced by an amount of an agency commission.

However, Among discloses a step of determining (*login*) who the user is, determining if a passenger is identified as qualified for special pricing and automatically applying a rate if qualified (*Figure 4 step 407 If passenger identified as qualified for special pricing – rate is automatically applied*), a customer information database (106) which includes client and customer information and identification [0039], allowing for tracking of sales by an individual or by an entity, sending confirmation messages to travel agent 605 and the buyer (606) and the ability to enroll online in an incentive program and receive special access to the site via the login and password which includes a travel agent [0052] (*Figure 1 (102)(101) login, Figure 3 (300) customer inputs: resident state, name, other login information; page 5 [0052]*).

Among further discloses in addition to sending confirmation to the vendors 602, a confirmation message is also sent to any travel agent 606 that booked the package and to the buyer [0051].

Among discloses an invention wherein the travel agents can manage commission payment [0052].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the login teachings of Among with travel planning disclosure of Jones since, by identifying the user, the travel planning method and system of Jones would have access to information about special pricing, incentives, and commission payments that may be available to the user, thus allowing for the user to receive the special pricing, and also allowing for the tracing of sales by an individual or by an entity which would aid travel agents in managing commission payments. .

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine sending a confirmation message to any travel agent, vendor or buyer taught in Among with the travel planning disclosed in Jones for the purpose of providing verification that the reservation was made.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the commission payment taught in Among with the travel planning disclosed in Jones to allow for travel agents to manage and receive their commission payments and for the tracking and reporting of sales.

Furthermore, the fact that the user is a direct user or a travel agent in the claim language above is determined to be non-functional descriptive data, not structurally related to the steps or the structure. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d

1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

As for appellant's argument that there is not motivation to combine, the Examiner respectfully disagrees.

As set forth above, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in paragraph [0052] of the prior art reference, Among.

8. Combination of Jones and Among Fails to Disclose Determination of Whether a User is a Direct Customer or a Travel Agent in Independent Claim 28.

Appellant argues Among does not disclose determining whether the user is a direct customer or a travel agent. The Examiner respectfully disagrees.

First, the Examiner directs the Board to the statement on page 25 of the appellant's appeal brief wherein appellant states that combining Jones and Among would change the principle of operation of Jones from being a goal oriented travel planning system for a user **to an incentive based travel system that can determine whether the user is a direct customer or a travel agent**. The Examiner takes this as an admission by appellant that Among discloses determining whether the user is a direct customer or a travel agent.

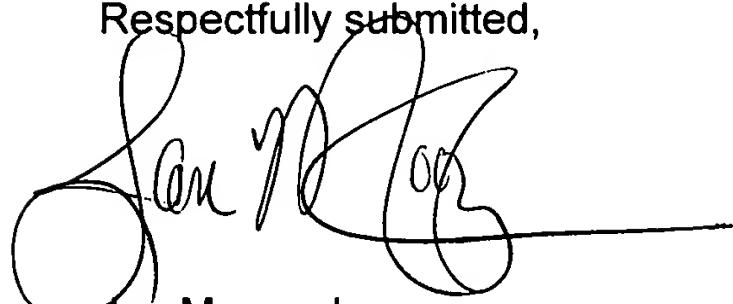
As discussed in the rejection above, Among discloses a step and structure for determining (*login*) who the user is, determining if a passenger is identified as qualified for special pricing and automatically applying a rate if qualified (Figure 4 step 407 If passenger identified as qualified for special pricing – rate is automatically applied), a customer information database (106) which includes client and customer information and identification [0039], allowing for tracking of sales by an individual or by an entity, sending confirmation messages to travel agent 605 and the buyer (606) and the ability to enroll online in an incentive program and receive special access to the site via the login and password which includes a travel agent [0052] (*Figure 1 (102)(101) login, Figure 3 (300) customer inputs: resident state, name, other login information; page 5 [0052]*).

Furthermore, the Examiner asserts that the fact that the user is a direct user or a travel agent, as claimed in the claim language, is determined to be non-functional descriptive data, not structurally related to the steps or the structure. Once the user is identified, this information is not used in the claim language. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994).

Moreover, a login is a form of gaining access to a specific computer, a program, or a network by identifying oneself with a username and a password. Thus, each time one logs into a system, the system identifies the person logging in, whether it be a direct customer or a travel agent.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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